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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|-------------------|
| 09/168,072 | 10/08/1998 | NICK MARCHESANI | 2413-101A | 2085 |
| 24633 | 7590 | 05/21/2007 | EXAMINER | |
| HOGAN & HARTSON LLP IP GROUP, COLUMBIA SQUARE 555 THIRTEENTH STREET, N.W. WASHINGTON, DC 20004 | | | | PIERCE, WILLIAM M |
| ART UNIT | | PAPER NUMBER | | |
| 3711 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/168,072 | MARCHESANI, NICK |
| | Examiner | Art Unit |
| | William M. Pierce | 3711 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 February 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 28-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 28-62 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claims 28, 31-34, 39,40,57 and 59-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Srichayaporn for the reasons set forth in the previous office action and below in response to applicant's remarks. Breeding and Shen have been removed from the grounds for rejection in order to condense the issues.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 29,30,35-38,41,43-56,58 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srichayaporn in view of Franklin 5,597,162 and matters well known to card games as set forth in the previous office action and below in response to applicant's remarks.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srichayaporn in view of Franklin 5,597,162 and matters well known to card games and further in view of Banyai as set forth in the previous office action and below in response to applicant's remarks.

Conclusion

Applicant's arguments filed 2/1/05 have been fully considered but they are not persuasive.

Applicant's remarks on pg. 12-14 with respect to Srichayaporn take issue with the fact that he shows more than one wager possible. In what has been dubbed as a "dual betting" method (middle of pg. 13) in Srichayaporn he contrasts to his single wager (middle of pg. 14). This limitation explicitly recited of "having each player make a single wager prior to viewing the face value of their respective cards" is still considered met by the method of Srichayaporn by the act of placing more than one wager. This interpretation of the claim is based on the open language "comprising" in which it is written. As such the grounds for rejection remains and this limitation fails to distinguish over the applied art.

Alternatively, clearly applicant can make limitations reciting for example "one and only one" wager or the like. However, in view of the prior art, traditional pai gow, is conventionally played with only a single wager. Breeding 5,248,142 shows a single wager 24 on a high/low game, Franklin 5,584,486 shows a single wager 21S on a high/low game and Lo 5,863,042 shows single wagers 404. As such, the examiner cannot offer any suggestions since applicant's invention is considered more than fairly taught by the prior art.

With respect to the limitations in claim 28 of two "half-hands" argued in the last paragraph of pg. 14, Srichayaporn shows the "initial hand may comprise four tiles, the high hand may comprise two tiles, and the low hand may comprise two tiles" (col. 3, ln. 25. This explicitly shows the limitations that the number of cards be in the range "from 3 to 7" or 4 and two cards in each hand shows where "either half-hand does not exceed

the total number of cards in the other half-hand by more than one card". As such, this limitation fails to distinguish over that applied art.

Once again considering this limitation in view of the art as a whole with respect to number of cards in each had, Lo teaches that there can be 2,2 or 3,2, Shen 4,659,087 teaches 2,2. Clearly, in view of the prior art, the number of cards has not been shown to be critical to applicant's claimed invention.

Shen and Breeding have been removed from the statement of the grounds from rejection to make it more clear as set forth above. As such, no further reply with respect to these references is included.

With respect to the rejection under 103, claim 29 explicitly recites that "said players may opt to discard...and draw a replacement card upon the payment of a fee". Most broadly interpreted this limitation is optional. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

It is not a required step since a player "may opt" not to discard and draw a replacement. For the reasons above alone, this language of claim 29 does not distinguish over Srichayaporn.

More specifically with respect to Malek, the teachings of Franklin'162 have been substituted for him as set forth in the grounds for rejection above. Franklin clearly teaches allowing a fee or a wager for a replacement card in a wagering game in order to allow a player the opportunity to better his hand. Certainly, applicant is not the inventor or allowing to buy additional cards or replace cards for a fee in a wagering game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on **Monday and Friday 9:00 to 7:00**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WILLIAM M. PIERCE
PRIMARY EXAMINER